

REMARKS

Claims 2 through 5 and 7 through 18 are pending in this Application, of which claims 8 through 15 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R.

§ 1.142(b). Accordingly, claims 2 through 5, 7 and 16 through 18 are active.

Claims 1 and 6 cancelled and replaced by new claims 16 and 17, respectively, and new claim 18 added. The dependency of claims 2 through 5 and 7 has been appropriately changed. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, noting that new claim 18 is similar to objected to claim 7 and finds adequate descriptive support in Fig. 8 and the related discussion thereof in the written description of the specification, noting page 25. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 4 and 6 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Johnson.

In the statement of the rejection the Examiner referred to various portions of the patent text, asserting the disclosure of a method corresponding to those claimed. This rejection is traversed.

Initially, Applicants will treat this rejection as though applied against claims 16 and 17, because claims 16 and 17 replaced independent claims 1 and 6, respectively.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir.

2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed methods and Johnson's method that scotch the factual determination that Johnson discloses a method identically corresponding to those claimed.

Specifically, the method defined in independent claim 16, which replaced claim 1, comprises a sequence of manipulative steps including: temporarily connecting a plurality of optical fibers having different transmission characteristics therebetween to make a provisional transmission line; inputting light into one end of the temporarily connected optical fibers; detecting a rerun back light from the one end of the temporarily connected optical fibers; evaluating characteristic information of the return-back light; and constructing a permanent optical transmission line based on the results of the evaluation. In other words, when the result of the evaluation of the provisional transmission line is desired, the plurality of optical fibers of the provisional transmission line are connected to construct a desired optical transmission line. However, when the result of the evaluation of the provisional transmission line is not desired, one of the plurality of the optical fibers of the provisional transmission line is changed to another optical fiber having transmission characteristics different from the changed optical fiber, to make a new provisional transmission line. An evaluation of the new provisional line is then performed and a desired optical transmission line constructed.

Further, in accordance with the method defined in independent claim 17, which replaced claim 6, as well as in new claim 18, a desired transmission line is constructed based on result(s) of evaluation of the optical fiber(s) to be connected. In independent claims 17 and 18, it is specifically required that when the results of the evaluation of the optical fiber are desired, the optical fibers are connected to construct a desired optical transmission line. However, when any

one of the results of the evaluation of the optical fiber is not desired, another optical fiber is selected and evaluated to construct the desired optical transmission line.

Johnson neither discloses nor suggests a method as defined in any of the independent claims. Specifically, Johnson discloses that a plurality of optical fibers are independently and individually connected to a splitter provided in OTDR. In other words, in accordance with the methodology of Johnson, the plurality of the optical fibers having different characteristics are evaluated **individually or independently**. As one having ordinary skill in the art would have understood, in Johnson's method, transmission characteristics of a transmission line in which optical fibers having different characteristics **are connected**, are **not** evaluated. Moreover, as one having ordinary skill in the art would have also understood, Johnson neither discloses nor suggests **construction of a transmission line based on evaluation of characteristics of the transmission line itself**. Specifically, Johnson neither discloses nor suggests that when the results of the evaluation of the optical fiber are desired, the optical fibers are connected to construct a desired optical transmission line and, when any one of the results of the evaluation of the optical fiber is not desired, another optical fiber is selected and to perform an evaluation of the other optical fiber is preformed in order to construct the desired optical transmission line.

The above argued differences between the methods defined in each of independent claims 16 and 17 vis-à-vis Johnson's method undermine the factual determination that Johnson discloses a method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 16 (which

Application No.: 10/821,190

replaced claim 1), 4 and 17 (which replaced claim 6) under 35 U.S.C. § 102 for lack of novelty as evidenced by Johnson is not factually viable and, hence, solicit withdrawal thereof.

Claims 2, 3 and 5 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Johnson.

This rejection is traversed.

Firstly, claims 2, 3 and 5 depend from independent claim 16, the patentability of which has been argued *supra*. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 16 under 35 U.S.C. § 102 for lack of novelty as evidenced by Johnson. The additional comments offered by the Examiner do not cure the previously argued deficiencies of Johnson.

Further, the Examiner has not provided any factual basis to isolate the recited characteristics as art-recognized result effective variables in the particular fibers disclosed by Johnson. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Yates*, 663 F.2d 1054, 211 USPQ 1149 (CCPA 1981); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Accordingly, the separate patentability of claims 2, 3 and 5 is advocated.

Based upon the foregoing Applicants submit that the imposed rejection of claims 2, 3 and 5 under 35 U.S.C. § 103 for obviousness predicated upon Johnson is not factually or legally viable and, hence, solicit withdrawal thereof.

New Claim 18.

New claim 18 is clearly free of the applied prior art. As previously pointed out, in accordance with the method defined in claim 18, a desired transmission line is constructed based

the result(s) of evaluating the optical fiber(s) to be connected. Claim 18 requires that when the results of the evaluation of the optical fiber are desired, the optical fibers are connected to construct a desired optical fiber transmission line and, when any one of the results of the evaluation of the optical fiber is not desired, another optical fiber is selected and an evaluation of that fiber is performed to construct the desired optical transmission line. No such methodology is disclosed or suggested by Johnson. Johnson neither discloses nor suggests that when the results of the evaluation of the optical fiber are not desired, another optical fiber is selected and evaluated to construct a desired optical transmission line.

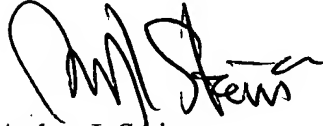
Applicants acknowledge, with appreciation, the Examiner's indication that claim 7 contains allowable subject matter. Based upon the foregoing it should be apparent that the imposed rejections have been overcome, and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/821,190

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Arthur J. Steiner', with a stylized flourish at the end.

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